Changes to Continued Prosecution Application Practice


Action: Interim rule with request for comments.

Summary: The Patent and Trademark Office (Office) is amending its regulations to remove the requirement that the prior application of a continued prosecution application (CPA) must have been filed on or after June 8, 1995. This requirement is being removed in response to requests from the public.


Applicability Date: This rule change applies to all continued prosecution applications filed on or after December 1, 1997.

Comment Deadline Date: To be ensured of consideration, written comments must be received on or before April 6, 1998. No public hearing will be held.

Addresses: Comments should be sent by mail message over the Internet addressed to regrefom@uspto.gov. Comments may also be submitted by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents, Washington, DC 203231, or by facsimile to (703) 308-6916, marked to the attention of Hiram H. Bernstein. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. Where comments are submitted by mail, the Office would prefer that the comments be submitted on a DOS formatted 3¼ inch disk accompanied by a paper copy.

The comments will be available for public inspection in Suite 520, of One Crystal Park, 2011 Crystal Drive, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: ftp.uspto.gov). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

For Further Information Contact: Concerning this Interim Rule: Hiram H. Bernstein or Robert W. Bahr, Senior Legal Advisors, by telephone at (703) 305-9285, or by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents,
Concerning Sec. 1.53 in General: John F. Gonzales, Fred A. Silverberg, or Robert W. Bahr, Senior Legal Advisors, at the above-mentioned telephone number.

Supplementary Information: Section 1.53(d), as amended on December 1, 1997, provides for the filing of a continued prosecution application (CPA). See Changes to Patent Practice and Procedure; Final Rule, 62 FR 53131 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63 (October 21, 1997) (Final Rule). Section 1.53(d)(1)(i) requires, inter alia, that the prior application of a CPA under Sec. 1.53(d) had been filed on or after June 8, 1995. See Final Rule, 62 FR at 53186, 1203 Off. Gaz. Pat. Office at 112. The rationale for this requirement was:

Permitting the continued prosecution application practice to be applicable in instances in which the prior application was filed prior to June 8, 1995, would result in confusion as to whether the patent issuing from the continued prosecution application is entitled to the provisions of 35 U.S.C. 154(c). As the continued prosecution application practice was not in effect prior to June 8, 1995, no patent issuing from a continued prosecution application is entitled to the provisions of 35 U.S.C. 154(c).

[The] application number of a continued prosecution application will be the application number of the prior application, and the filing date indicated on any patent issuing from a continued prosecution application will be the filing date of the prior application (or, in a chain of continued prosecution applications, the filing date of the application immediately preceding the first continued prosecution application in the chain). Thus, any patent issuing from a continued prosecution application, where the prior application was filed prior to June 8, 1995, will indicate that the filing date of the application for that patent was prior to June 8, 1995, which will confuse the public (and possible [sic] the patentee) into believing that such patent is entitled to the provisions of 35 U.S.C. 154(c).


The rules of practice formerly permitted an applicant to obtain further examination by the filing of a file wrapper continuing (FWC) application under Sec. 1.62. Effective December 1, 1997, however, FWC practice under Sec. 1.62 was abolished in favor of CPA practice under Sec. 1.54(d). See Final Rule, 62 FR at 53147, 1203 Off. Gaz. Pat. Office at 76–77. As discussed above, Sec. 1.53(d)(1)(i) requires that the prior application of a CPA be filed on or after June 8, 1995. When the prior application was filed before June 8, 1995, and an applicant desires to file what would formerly have been a file wrapper continuation (or divisional), Sec. 1.53 as adopted requires that such a continuation (or divisional) application be filed under Sec. 1.53(b).
Section 1.53(b) requires that any application filed thereunder (including a continuation or divisional) contain a specification (including at least one claim) and any necessary drawing. While Sec. 1.53(b) permits the submission of a rewritten specification (with all prior amendments incorporated), such an option is only practical to those who have the prior application in electronic form. For those applicants who do not have the prior application in electronic form, their only option is to submit a copy of the prior application (including any appendix) along with a copy of all the amendments made in the prior application, as well as copies of all other papers filed in the prior application (e.g., information disclosure statements (IDS’s), affidavits, declarations) that are to be considered in the continuing application.

Subsequent to the adoption of the change to Sec. 1.53(d), the Office has received a number of comments indicating that it will take a considerable amount of time to prepare the papers required by Sec. 1.53(b), even when copied from a prior application.

In view of these concerns, the Office is amending Sec. 1.53(d)(1)(i) to eliminate the requirement that the prior application of a CPA had been filed on or after June 8, 1995. Section 1.53(d)(1)(i) as adopted will require that the prior application of a CPA be a nonprovisional application that is either: (1) complete as defined by Sec. 1.51(b); or (2) the national stage of an international application in compliance with 35 U.S.C. 371.

As noted in the Final Rule (quoted above), no patent issuing from a CPA under Sec. 1.53(d) is entitled to the provisions of 35 U.S.C. 154(c). To avoid confusion as to the term of any patent issuing on a CPA of an application filed before June 8, 1995, the Office will include a notice on any patent issuing on a CPA, other than a reissue or a design patent, that: (1) the patent issued on a CPA; and (2) the patent is subject to the twenty-year patent term set forth in 35 U.S.C. 154(a)(2). The term of a design patent is defined in 35 U.S.C. 173 as fourteen (14) years from the date of grant. The term of a reissue patent is defined in 35 U.S.C. 251 as the unexpired part of the term of the original patent. Since the term of any reissue or design patent is not affected by the filing of a CPA, no notice will be printed on either a reissue or a design patent.

Interested members of the public are invited to present written comments on the change to Sec. 1.53(d)(1)(i) contained in this Interim Rule.

Other Considerations

The Commissioner of Patents and Trademarks, pursuant to authority at 5 U.S.C. 553(b)(3)(B), finds good cause to adopt the changes made in this Interim Rule without prior notice and an opportunity for public comment, as such procedures are contrary to the public interest. Delay in the promulgation of this rule to provide notice and comment procedures would cause harm to those applicants who must file a continuation or divisional application promptly to meet the copendency requirements of 35 U.S.C. 120 and who would not be permitted to file a CPA due to the restriction in Sec. 1.53(d)(1)(i). Moreover, immediate implementation of this rule is in the public interest because those applicants currently subject to the prohibition will benefit from the efficiencies and savings resulting from the
new rule. See Nat. Customs Brokers & Forwarders Ass’n v. U.S., 59 F.3d 1219, 1223–24 (Fed. Cir. 1995). Finally, pursuant to authority at 5 U.S.C. 553(d)(1), this rule may be made immediately effective because it relieves a restriction.

As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553, or any other law, the analytical requirements of the Regulatory Flexibility Act, 5 U.S.C. 6012 et seq., are inapplicable.

This rule involves a collection of information subject to the Paperwork Reduction Act, 44 U.S.C. ch. 35, previously approved by the Office of Management and Budget under OMB Control Number 0651-0032. Notwithstanding any other provision of law, no person is required to respond nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB Control Number.

This rule does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 12612 (October 26, 1987).

This rule has been determined to be not significant for purposes of Executive Order 12866 (September 30, 1993).

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons set forth in the preamble, 37 CFR Part 1 is amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 6, unless otherwise noted.

2. Section 1.53 is amended by revising paragraph (d)(1)(i) to read as follows:

Sec. 1.53 Application number, filing date, and completion of application.

* * * * *

(d) * * *

(1) * * *

(i) The prior nonprovisional application is either:
(A) Complete as defined by Sec. 1.51(b); or

(B) The national stage of an international application in compliance with 35 U.S.C. 371; and

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Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.